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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/694,136 | 10/23/2000 | Herbert M. Straub | 20003 | 9008 |

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EXAMINER

FERGUSON, LAWRENCE D

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| ART UNIT | PAPER NUMBER |
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1774

DATE MAILED: 03/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/694,136

Applicant(s)

STRAUB ET AL.

Examiner

Lawrence D Ferguson

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15, 17, 18 and 20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15, 17-18 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. This action is in response to the amendment mailed December 12, 2003. Claims 1-15, 17-18 and 20 were amended and claims 16 and 19 were canceled rendering claims 1-15, 17-18 and 20 pending.

Claim Rejections – 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-15, 17-18 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In instant claims 1-15, 17-18 and 20, the phrase, "a paper decorative wrapping film" is indefinite. It is unclear whether Applicant is claiming a paper or a film.

Clarification is requested.

Claim Rejections – 35 USC § 103(a)

4. Claims 1-15, 17-18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kotin (U.S. 5,996,672) in view of Salgado et al. (U.S. 6,361,839).

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5. Kotin discloses a decorative film having an embossed paper substrate that is easy to print (column 6, lines 44-50) with an adhesive applied to the back of the film (column 6, lines 34-36). Kotin also discloses the decorative film is laminated (column 3, lines 26-28 and column 6, lines 1-2). The reference discloses a substrate is wrapped with a printed film (column 4, lines 34-36) where the film is flexible and can be a foil wrap (column 2, lines 59-67). In instant claims 3-4 and 13-14, the phrase "to be decorated" constitutes a 'capable of' limitation and that such a recitation that an element is 'capable of' performing a function is not a positive limitation but only requires the ability to so perform. Although Kotin does not specifically teach rolling the wrapping film, wrapping an article or substrate constitutes rolling the decorative film around an article. Kotin does not disclose the decorative wrapping film comprising a hot transfer inked foil, which is removable, translucent or opaque.

Salgado teaches a hot stamping foil comprising a carrier (column 1, line 67 through column 2, line 1) where the carrier of the hot stamping foil is removable (column 2, lines 18-22) where the hot stamping foil may be applied to wood or paper (column 2, lines 23-27). Salgado further teaches the foil material may be colorless or a variety of colors depending on temperature (column 3, lines 8-15). It would have been obvious to one of ordinary skill in the art to include a colorless (translucent) or colored (opaque) hot stamping foil on the laminated decorative film of Kotin because Salgado teaches the conventionality of applying a hot stamping foil to a substrates such as wood or paper, which Kotin comprises, which improves the transfer of ink images onto a substrate (column 1, lines 13-14).

Response to Arguments

6. Applicant's arguments of rejection under 35 USC 103(a) as unpatentable over Suess et al. (U.S. 5,985,078) in view of Abrams (U.S. 5,908,527) are moot based on grounds of new rejection. Applicant's arguments of rejection under 35 USC 103(a) as unpatentable over Abrams (U.S. 5,653,844) in view of Nelson (U.S. 4,724,026) are moot based on grounds of new rejection. Applicant's arguments of rejection under 35 USC 103(a) as unpatentable over Weder (U.S. 6,324,813) in view of Nelson (U.S. 4,724,026) are moot based on grounds of new rejection.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is 571-272-1522. The examiner can normally be reached on Monday through Friday 9:00 AM – 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly, can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Lawrence D. Ferguson
Examiner
Art Unit 1774

CYNTHIA H. KELLY
SUPERVISOR
TECHNOLOGY CENTER 1700

